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In re Application of	:	
Theodorus Joseph Aquarius et al	:	DECISION ON
Application No.: 10/031,111	:	
PCT No.: PCT/NL01/00351	:	
Int. Filing Date: 08 May 2001	:	RENEWED PETITION
Priority Date: 08 May 2000	:	
Attorney's Docket No.: A-71266/ESW	:	
For: DEVICE FOR MANUFACTURING...	:	UNDER 37 CFR 1.47(b)
AND TUBULAR FOIL	:	

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(b)" submitted on 25 August 2003.

BACKGROUND

In a decision from this Office on 18 March 2003, the petition filed on 16 October 2002 was dismissed. The decision stated that items (2), and (5) under 37 CFR 1.47(b) had not been met.

On 25 August 2003, applicant submitted this renewed petition accompanied with the petition, inter alia, was a supplement statement of Edward S. Wright

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has still not satisfied items (2) and (5) thus not completing the requirements under 37 CFR 1.47(b).

Regarding requirement (2) under 37 CFR 1.47(b), the averments of Mr. Wright are insufficient to support a finding that the nonsigning inventors refused to signed the declaration as well as the assignment since a complete set of application papers were not presented to them for their signature. Mr. Wright indicates that "it is unnecessary because because the application which was filed in the U.S. was the published PCT application, and that Vriesendorp already had that." However, it unclear if the declaration submitted to the non-signing inventors would show that they were aware that the US application filed was the same as the published PCT application since Mr. Wright has not provided a copy of the declaration sent to them and showing that it executes the PCT in the United States. Moreover, it is unclear if they are in possession of the application as filed in the USPTO.

If applicant can not affirmatively prove that the non-signing inventors were in possession of the application as filed in the USPTO, then before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventors for their signature. The relevant paragraph of MPEP § 409.03(d) is illustrated below:

"... Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney...."

It would appear from Mr. Wright's statements that they were only given the declaration and the assignment to sign and not a complete copy of the application as required by MPEP Section 409.03(d). In addition, no documentary evidence such as certified mail return receipt, cover letter instructions, etc., has been introduced into the file record that the inventors were presented with the declaration let alone the complete application.

Regarding requirement (5) under 37 CFR 1.47(b), applicant only conclusively states that Free-Flow Packaging has a proprietary interest based on one of nonsigning the inventors, Mr. Straver's employment with Free-Flow but applicant has not submitted proof of Mr. Straver's employment agreement. Accordingly, no agreement acknowledging ownership of the invention by Free-Flow Packaging International, Inc has been provided.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of the same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f).


Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

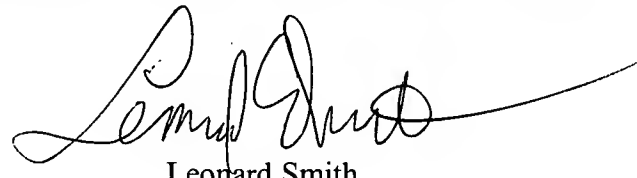
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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